FISH & RICHARDSON P.C.

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number: 15786-042001

	Application Number 09/755,975	Filed January 5, 2001
I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail label no. EV741502774US in an envelope addressed to Mail Stop AF, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.	First Named Inventor Leonid Raiz et al.	
<u>May 1, 2006</u> Date of Deposit _Schuster_ Signature	Art Unit 2135	Examiner Song, Hosuk
<u>Brenda Schuster</u> Typed or Printed Name of Person Signing Certificate		

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.
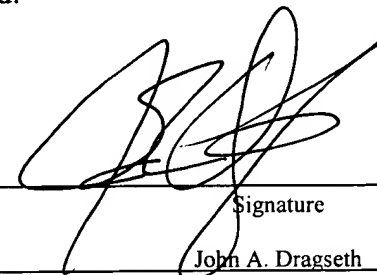
This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
    See 37 CFR 3.71. Statement under 37 CFR 3.73(b)
    is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record <u>42,497</u>
                    (Reg. No.)

☐ attorney or agent acting under 37 CFR 1.34.
    Registration number if acting under 37 CFR 1.34

_____
Signature

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Typed or printed name

<u>(612) 335-5070</u>
Telephone number

<u>May 1, 2006</u>
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below'.

☒ Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Leonid Raiz et al.	Art Unit	: 2135
Serial No.	: 09/755,975	Examiner	: Song, Hosuk
Filed	: January 5, 2001		
Title	: SOFTWARE USAGE/PROCUREMENT MANAGEMENT		

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

This request for review accompanies Applicant's Notice of Appeal under the PTO's OG Notice of 12 July 2005. Panel review is required because the rejections here are based on plain legal errors. We address one primary error below that applies to all of the pending claims.

Claims 1-43 are pending; claims 1, 32, and 43 are the independent claims. The claims have been rejected either as anticipated by U.S. Patent 6,343,280 to Clark (claims 1-2, 4-7, 11, 13, 16, 18, 20, 23-24, 27, and 30) or obvious in light of the Clark patent and other patents. The arguments in this Request turn on plain legal errors.

Brief Introduction to the Technology and Prior Art

The pending application relates to methods for regulating the usage of software. As recited in claim 1, the method involves the use of a subscription server to distribute authorization keys to other computers, where each of the keys is associated with a validity period. Those computers have copies of an application program stored on them, and the application programs are allowed to run during a certain validity period. New authorization keys are distributed to each of the computers at intermittent times in a manner that is transparent to the users of the computers.

With this invention (and the further inventions recited in the other claims), users can be given flexible usage and pricing policies, while the intellectual property of the software publisher is protected. (See Application at page 5, lines 1-16.) In addition, the publisher or vendor need not provide human intervention to allow for such protection and flexibility. Moreover, the

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methods may provide for an initial subscription period for a user during which the user can decide to license or purchase the software, followed by an ongoing subscription option until the user cancels the subscription. *(Id.)*

Legal Error: Ignoring the Requirement that Application Programs Be Stored on the Computers on Which the Programs are to Be Run

It is plain legal error to read a feature entirely out of a claim, or to ignore a feature positively recited in a claim. *See Pause Technology LLC v. Tivo Inc.*, Docket No. 04-1263, at 15-16 (Fed. Cir. Aug. 16, 2005) (rejecting claim construction that would ignore claim term "predetermine"); *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1105 (Fed. Cir. 1996) (refusing to adopt a claim construction that would ignore a claim limitation); *Texas Instruments Inc. v. United States Int'l Trade Comm'n*, 988 F.2d 1165, 1171 (Fed.Cir.1993) ("[T]o construe the claims in the manner suggested by TI would read an express limitation out of the claims. This we will not do....").

The examiner here has improperly read out of all the pending claims the requirement that copies of an application program be stored on the computers to which the authorization keys are distributed. By storing applications on the computers that will run them, the system can be operated simply. For example, the connection between the computers and the authorization server need not carry much information for authorization. Also, the application can be expected to run more efficiently and without error when it is stored locally. In addition, the computer need not be connected to the authorization server for running the application when it has its key.

The Clark patent does not store any application on the computers. Rather, it works in a much more complex and inflexible manner by splitting up the application into snippets, and storing the snippets (but no application) on the various computers. The computers (e.g., user computers) do not get an application program, but instead gets only snippets of code. *See* Clark Patent, col. 14, lines 31-51. The other snippets are provided to a "License Server." In operation, the "Original Software" is provided to a "Software Profiler," and the user gets only "Modified Software" that is not an application program, along with a key and some "Trap Software." *Id.* The Modified Software only works when the user contacts the license server, and the other components are run from the license server. *See id.*, col. 14, lines 55-62. Splitting the

application up in this manner appears to be the way in which the Clark patent prevents people from pirating the software.

The difference between the Applicants' claimed methods, which place the application on the computers, and the Clark method, which places only snippets of code on the computers, is fundamental, and is not suggested by any of the art applied by the Examiner. For example, the Clark system requires the special "Trap" software that allows the snippets of code on the user's computer to interoperate with the snippets of code on the license computer, since neither computer actually contains an application program. This complicated process is shown in Figure 2 of the Clark patent (below), whereby, whenever a hole in the code on the user's computer is located, the trap software has to verify the user's key with the license server, send a CPU state to the license server, wait for the license server to emulate instructions that are missing from the user's computer, and then incorporate any changes back into the user's computer and continue running whatever code is available on the user's computer.
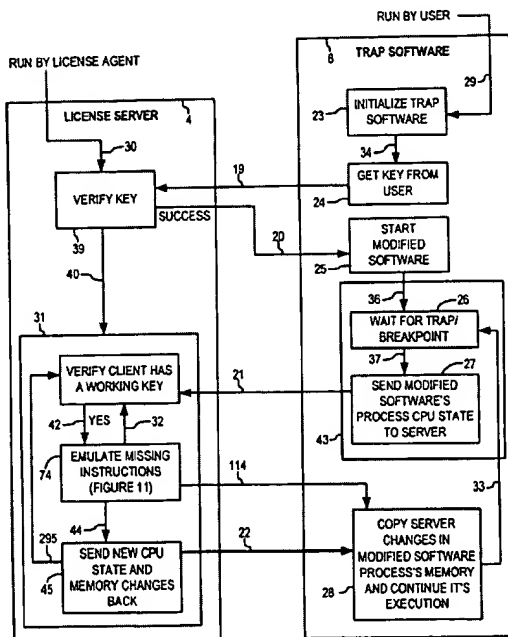

FIG. 2

This complex process introduces a whole host of communication and coordination errors that are not present with the invention recited in pending claims. In fact, the Clark patent itself

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recognizes that the remote code will "execute[] more slowly because of the time of network transfer" (and requires a special Software Profiler in an attempt to split the code so as to minimize such delays). *See* Clark Patent, col. 21, lines 62-65. Also, the process requires a constant, reliable connection to the license server—yet another complicating factor involved with the Clark patent's system and method. In short, the Clark patent neither discloses nor fairly suggests the inventions of the pending claims, and the Applicants respectfully request allowance of the claims.
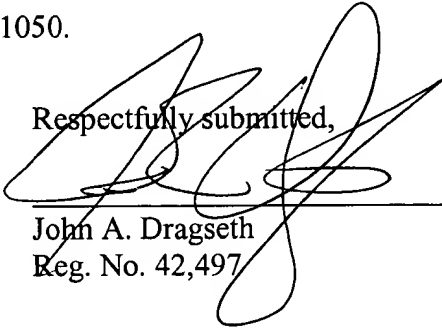
In the final Office Action, the examiner stepped around this central issue. First, the examiner focused on a perceived requirement of a "user" computer—noting that the claims do not require the application to be on any particular computer. But that is not the basis on which the Applicant distinguished Clark—instead, the Applicants pointed to the fact that Clark does not store any application at all. Second, the Examiner appears to have reworded the claims by noting that "software" is stored on the computers. The pending claims, however, do not simply recite "software" of any sort on a computer—they call for an application on the computer. In sum, the examiner has failed to address the actual requirements of the claims and read a clear and fundamental limitation out of the claims—a plain legal error.

Enclosed is a $225 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 5/1/06

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